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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nordson Corporation

Serial No. 75/578,830

Raymond J. Slattery III for applicant.

Sean W. Dwyer, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Nordson Corporation
to register the representation shown below



for "metal nozzles for hot melt adhesive guns; metal nozzles for modules; and metal nozzles for dispensers, all used for dispensing hot melt adhesives."¹ The application includes the following description: "The mark comprises two (2) rings or grooves which are spaced from one another and encircle a substantial portion of the metal nozzle for dispensing hot melt adhesive. The matter shown in the drawing in broken lines serves only to show positioning of the mark and no claim is made to it." The application also includes the following statement: "The stippling in the drawing is for shading purposes only and is not indicative of color."

The Trademark Examining Attorney has refused registration on the Principal Register under Sections 1,2 and 45 of the Trademark Act on the ground that the mark sought to be registered is *de facto* functional and, thus, lacks inherent distinctiveness.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Before turning to the merits of the appeal, we are compelled to state that the examination of the application

¹ Application Serial No. 75/578,830, filed October 28, 1998, alleging a bona fide intention to use the mark in commerce.

by a previous Examining Attorney, up to and including the final refusal, is hardly a model of clarity. In saying this, it also should be noted that the current Examining Attorney was not involved in this case until the briefing stage of appeal. It is apparent, however, as applicant has pointed out in its reply brief, that both Examining Attorneys struggled with getting a grasp on the specific ground of refusal. This, in turn, complicated applicant's prosecution of the application.

In the final refusal, the Examining Attorney refused registration based on functionality and lack of inherent distinctiveness. The Examining Attorney stated the following:

Here the mark is not *de jure* functional because the applicant has shown evidence via the information in its patent of other available and competitive designs. It is however, *de facto* functional and does serve some purpose as a physical means of identifying the size of the nozzle. The mark is either "two rings or grooves" which means that they are cut into the metal nozzle. As such they are part of the goods, and since they serve an identifying function, it does serve a utilitarian function.

The Examining Attorney also refused registration because "the mark is a configuration of the goods which is not inherently distinctive." According to the Examining

Attorney, "the mark would not be readily perceived as a distinctive source indicator, but rather as a representation of the goods themselves or a part thereof."

In his brief, the Examining Attorney asserts that the applicant's mark "is clearly product design" and that "applicant's drawing clearly shows that the mark is the product design of a nozzle consisting of two grooves or indented rings," and that the "groove design is a product design of a nozzle." (brief, p. 4). After pointing out that applicant failed to submit any evidence of acquired distinctiveness, the Examining Attorney then states that even if such evidence had been submitted, it would have been to no avail because "applicant's product design is functional and is therefore unregistrable," citing to the recent Supreme Court decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 121 S. Ct. 1255 (2001).² The Examining Attorney then goes on to discuss the mark in terms of utilitarian or functional features, that is, *de jure* functionality.

Applicant has a point when it states, in its reply brief, that the present Examining Attorney, in his brief,

² Given that the representation of applicant's nozzle is in dotted lines and that the description of the mark specifically indicates that the drawing shows positioning of the mark on the nozzles, we fail to see how the mark is a configuration of the goods or a product design.

appears to be impermissibly raising a new ground of refusal. As noted above, in the final refusal, the Examining Attorney specifically stated that "the mark is not *de jure* functional." Thus, we will decide this case based on what also is stated in the final refusal, that is, that the mark sought to be registered is *de facto* functional in that it "does serve some purpose as a physical means of identifying the size of the nozzle" and, therefore, the mark is not inherently distinctive. (Office action dated December 10, 2001). Despite the Examining Attorneys' somewhat inconsistent treatment of applicant's mark, there was no prejudice to applicant. The basis for refusal was made clear in the December 26, 2000 Office action and in the December 10, 2001 final refusal; thus, applicant has been aware of the ground for refusal during the prosecution of the application.

In arguing against registration, the present Examining Attorney touches on *de facto* functionality and lack of inherent distinctiveness, contending as follows (brief, p. 3):

Specifically, the examining attorney argues that the grooves, used in connection with color codes and color-coded rings, serves to identify the size of applicant's nozzle. The examining attorney agrees with the applicant that the grooves in and of

themselves don't specify the size of the nozzle. The examining attorney argues that the grooves function as indentations where color codes and color-coded rings are placed to make certain colors remain on a nozzle in a lasting manner, thus, assisting in the identification of the size of a nozzle. In other words, the grooves help to identify the size of the nozzle in that the grooves ensure the color codes remain on a nozzle after a nozzle has been repeatedly tightened and loosened with a wrench.

It is clear from the record that the two rings or grooves are used for the placement of color (either by paint or by colored rings), and that the rings or grooves are functional in that they indicate the orifice diameter and the engagement dimension of the particular nozzle. Moreover, placing the color bands in the rings or grooves prevents the color from wearing off when a wrench is used to loosen or tighten the nozzle.

Applicant contends that the rings or grooves comprising its mark are not functional, pointing to the existence of design patents. Applicant asserts that the mark by itself is not functional, and that something else, as for example, color, is needed for the rings or grooves to be functional. Without color, applicant argues, nothing about the size of the nozzle is conveyed and, therefore, the rings or grooves are not in and of themselves

functional. Applicant states that a number of competitors sell nozzles which are similar in appearance to applicant's nozzles and that applicant placed the two rings or grooves on its nozzles so as to distinguish them from others in the trade. According to applicant, the rings or grooves are arbitrary, serving as an indicator that applicant is the source or origin of the nozzles.

The record includes various utility and design patents covering applicant's goods, including utility Patent No. 6,082,627 for "dispensing nozzle, gun and filter and method using visual identifiers for orifice size and engagement dimension." The "Field of Invention" states that the present invention "generally relates to fluid dispensing systems for dispensing liquid materials, such as hot melt adhesive, and, more specifically, manners of visually indicating different orifice sizes and engagement dimensions associated with the nozzles of such systems." The "Abstract" of the patent indicates that the nozzle "includes a nozzle body having a dispensing orifice with a diameter and an engagement dimension." It goes on to indicate that "[a] first visually identifiable indicium is provided on the body portion to indicate the orifice diameter and a second visually identifiable indicium is provided on the body portion independently from the first

indiciu to indicate the engagement dimension of the nozzle." The patent states that "both the orifice diameter and the engagement dimension are necessary factors to consider when determining the appropriate nozzle for a given application under specific material, pressure and temperature conditions." A significant problem in the industry with respect to these types of nozzles relates to replacement of the nozzles with like nozzles during maintenance and repair. Using the wrong nozzles adversely affects application of the viscous liquid material being dispensed. Thus, according to the patent, it "would be desirable to provide nozzles and other dispensing hardware having improved visual identification capabilities." In referring to the type of nozzle shown in the drawing of the involved application, the patent states that "the rings are affixed such that they do not interfere with the engagement of a wrench" and that this is accomplished by "sufficiently recessing [the] rings."

Design Patent No. 420,024 shows several different representations of applicant's nozzles, including a representation (Fig.-3) that shows the same nozzle depicted in the drawing of the involved application. The claim of the patent reads as follows: "The ornamental design for a nozzle for dispensing adhesives and sealants."

The distinction between *de facto* and *de jure* functionality has been explained by the Federal Circuit as follows:

Our decisions distinguish de facto functional features, which may be entitled to trademark protection, from de jure functional features, which are not. "In essence, de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid." In re R.M. Smith, Inc., 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). De facto functionality does not necessarily defeat registrability. In re Morton-Norwich, 671 F.2d 1332, 1337, 213 USPQ 9, 13 (CCPA 1982) (A design that is de facto functional, i.e., "'functional' in the lay sense...may be legally recognized as an indication of source."). De jure functionality means that the product has a particular shape "because it works better in this shape." Smith, 734 F.2d at 1484, 222 USPQ at 3.

The existence of a design patent may be some evidence of non-functionality. However, "the fact that a device is or was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark." In re R.M. Smith, supra at 3. See also: In re American National Can Co., 41 USPQ2d

1841 (TTAB 1997); and In re Caterpillar Inc., 43 USPQ2d 1335 (TTAB 1997).³

There is a functional aspect to the two rings or grooves that comprise applicant's mark in that the rings or grooves will be used for placement of color codes which, in turn, indicate orifice diameter and engagement dimensions. As the utility patent indicates, the rings or grooves "are affixed such that they do not interfere with the engagement of a wrench," and that this is accomplished by "sufficiently recessing rings" into the surface of the nozzle. Thus, the rings or grooves are functional in that they prevent the color coding, whether by paint or rings, from wearing off when a wrench is used to tighten or loosen the nozzle. In saying this, we recognize that the present mark is one step removed from showing colored rings or grooves, that is, there is no color claimed as part of the mark. The real question in the present case is whether purchasers would view the rings or grooves, in and of themselves, as a trademark, that is, whether the mark is inherently distinctive. We think not.

There is nothing of record which convinces us that

³ We would add that even if the mark were not *de facto* functional, but rather only incidentally ornamental, such ornamentation, in our view, would lack inherent distinctiveness.

purchasers would immediately perceive the two rings or grooves as a trademark. Rather, they will be viewed as simply the place where the color coding appears. Thus, purchasers will consider the rings or grooves, not as a trademark, but merely as a functional part of applicant's nozzles where color bands are placed so that users can easily and quickly identify orifice diameter and engagement dimension.

Accordingly, we find that the mark sought to be registered is not inherently distinctive, but rather would be registrable on the Principal Register only upon a sufficient showing of acquired distinctiveness under Section 2(f) of the Act.

Decision: The refusal to register is affirmed.